

REMARKS

This Amendment is made to the Office Action dated June 30, 2008. Claims 64 - 84 are pending in the present application. By this Amendment, claims 71 and 78 have been amended to more clearly define the presently claimed invention. These amendments were not made to distinguish the presently claimed invention over the cited prior art. Reconsideration of the application is respectfully requested.

The Examiner has rejected claims 64-70 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,808,186 to Smith (the "Smith patent"). Applicants disagree with the Examiner's position as regarding the Smith patent. Claim 64 recites an intracorporeal device comprising an elongated member having a longitudinal length and means for causing a substantially linear change in bending stiffness **over the entire longitudinal length** of the elongated member. The Examiner has indicated that the implant 58 disclosed in the Smith patent comprises the elongate member having a longitudinal length. The Examiner further indicates that the elongate member has at least three (3) tapered segments, namely, the components identified by reference numerals 32, 42 and 44. The portion of the elongated member designated by reference numeral 32 is referred to as a taper in the Smith patent. The component designated by reference numeral 42 is referred to as a neck and the component identified by reference numeral 44 is referred to as a stem. This elongated member 58 is best seen in Figures 1 and 7.

Applicants note that the Examiner has taken an inconsistent position as to what he regards as the elongated member 58 in attempting to show that the elongated member 58 has a longitudinal length and means for causing a substantial linear change in bending stiffness. In referring to the graph of Figure 7 in the Smith patent, the Examiner has erroneously indicated that the longitudinal length of the elongated member 58 only extends between the upper dashed line and the lower dashed line in Figure 7. However, the portion between the upper dashed line and the lower dashed line represents only the relative flexibility of the stem portion 44, not the entire longitudinal length of the elongated member 58 which the Examiner has admitted includes the stem and the neck

42 and taper 32. The Examiner's reliance on only a portion of the graph of Figure 7 only considers a portion of the elongated member 58, not the entire length (from the taper 32 to the end of the stem 44). Therefore, the Examiner only selects a portion of the elongated member 58 in taking the position and disregards the outer portions of the elongated member in order to support his position. This is a basic flaw in the Examiner's position and shows that the Examiner is simply selectively picking only those portions of the curves appearing in Figure 7 to support his position, while disregarding the other portion of the elongated member 58. In fact, the Examiner cannot rely on the graph of Figure 7 since the upper portions of the elongated member 58 is not represented. Therefore, there is no basis for the Examiner's position that the Smith device includes means for causing a substantially linear change in bending stiffness **over the entire longitudinal length** of the elongated member. Moreover, it is duly noted that the plot of the relative flexibility in the stem 44 portion is not substantially linear, as claimed by the Examiner, since there is a **significant** drop off of the plot at the center dashed line. Therefore, there is no reasonable basis for the Examiner's position that the elongated member 58 of the Smith device has a means for causing a substantially linear change in bending stiffness over the entire longitudinal length of the elongated member.

The Examiner has rejected claims 71-74, 76-81, 83 and 84 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,991,602 to Amplatz et al. (the "Amplatz patent") Applicants submit that the Amplatz patent fails to disclose an elongated member having means for causing a substantially linear change in stiffness over the longitudinal length of the elongated member. Applicants have amended independent claims 71 and 78 to include this recitation. Rather, the Amplatz patent only discloses a guidewire having tapered sections around reference numerals 12, 22 and 24 in Figure 2. Applicants submit that the Amplatz patent is devoid of any disclosure that the tapered section of its guidewire has a means for causing a substantially linear change in bending stiffness over the entire longitudinal length of the elongated member. In fact, there is complete lack of disclosure in the Amplatz patent which describes any type of bending stiffness that would

be associated with the tapered end of its guidewire. Applicants note that the Examiner previously rejected claim 64 claiming that the Amplatz device showed an elongated member having means for causing a substantially linear change in stiffness over the longitudinal length of the elongated member. In the present Office Action, the Examiner has withdrawn the rejection of claim 64 based on the Amplatz patent. Applicants submit that the Examiner apparently found Applicants' arguments to be persuasive regarding the failure of the Amplatz patent to show an elongated member having means for causing a substantially linear change in stiffness over the longitudinal length of the elongated member. Accordingly, the Amplatz patent does not anticipate the claims at issue in view of the amendments to claims 71 and 78 to include a similar recitation. For this reason alone, the Amplatz patent fails to disclose the presently claimed invention recited in claims 71-74, 76-81, 83 and 84. Applicants respectfully request the Examiner to withdraw the Amplatz patent as an anticipatory reference to claims 71-74, 76-81, 83 and 84.

The Examiner has rejected claims 71, 72, 75-79 and 82-84 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,497,786 to Urick (the "Urlick patent"). The failure of the Amplatz patent to disclose the structure of these claims, discussed in great detail above, applies equally to the Urick patent. In view of the amendment to claims 71 and 78, addressed above, it is submitted that the Urick patent, like the Amplatz patent, is completely devoid of any disclosure that the tapered section of its guide wire has a substantially linear change in bending stiffness over the longitudinal length of the elongated member. Moreover, there is complete lack of disclosure in the Urick patent which describes any type of bending stiffness that would be associated with the tapered end of its guidewire. Applicants also note that the Examiner previously rejected claim 64 claiming that the Urick device showed an elongated member having means for causing a substantially linear change in stiffness over the longitudinal length of the elongated member. In the present Office Action, the Examiner has also withdrawn the rejection of claim 64 based on the Urick patent. Applicants again submit that the Examiner

apparently found Applicants' arguments to be persuasive regarding the failure of the Urick patent to show an elongated member having means for causing a substantially linear change in stiffness over the longitudinal length of the elongated member. Accordingly, the Urick patent does not anticipate the claims at issue in view of the amendments to claims 71 and 78 to include a similar recitation. For this reason alone, the Urick patent fails to disclose the presently claimed invention recited in claims 71, 72 75-81, 83 and 84. Applicants respectfully request the Examiner to withdraw the Amplatz patent as an anticipatory reference to claims 71-74, 76-81, 83 and 84.

In view of the foregoing, it is respectively urged that all of the present claims of the application are patentable and in a condition for allowance. The undersigned attorney can be reached at (310) 824-5555 to facilitate prosecution of this application, if necessary.

In light of the above remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Please charge any fees payable in connection with this response to Deposit Account No. 06-2425.

Respectfully submitted,
FULWIDER PATTON LLP

By: /Thomas H. Majcher/
Thomas H. Majcher
Registration No. 31,119

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